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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1990

FEIST PUBLICATIONS, INC.,  
v. *Petitioner,*

RURAL TELEPHONE SERVICE COMPANY, INC.,  
*Respondent.*

On Writ of Certiorari to the  
United States Court of Appeals  
for the Tenth Circuit

BRIEF OF ASSOCIATION OF  
NORTH AMERICAN DIRECTORY PUBLISHERS,  
THE DIRECTORY PUBLISHERS ASSOCIATION,  
MEAD DATA CENTRAL, INC.,  
AND DONNELLEY MARKETING, INC.  
AS *AMICI CURIAE* IN SUPPORT OF PETITIONER  
FEIST PUBLICATIONS, INC.

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## QUESTION PRESENTED

Whether a copyright on a compilation of factual data published in the form of a directory is a proper basis for the copyright owner to claim a right to preclude the use of the data by others, in light of the statutory admonition that "[t]he copyright in a compilation . . . does not imply any exclusive right in the preexisting material," 17 U.S.C. § 103(b), and the fact that "[c]opyright does not preclude others from using the ideas or information revealed by the author's work." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 56, *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5670.

## TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES .....	v
PRELIMINARY STATEMENT .....	1
INTEREST OF THE <i>AMICI CURIAE</i> .....	1
STATEMENT OF THE CASE .....	3
SUMMARY OF THE ARGUMENT .....	5
ARGUMENT .....	7
I. THE 1976 COPYRIGHT ACT DEFINES THE NATURE AND SCOPE OF COPYRIGHTS IN COMPILATIONS OF FACTS .....	9
A. Nature Of "Compilations" .....	9
B. Limitations On The Scope Of Copyright In Compilations .....	9
II. THE 1976 COPYRIGHT ACT PROVIDES COPYRIGHT PROTECTION FOR COMPILA- TIONS ONLY AS WORKS OF AUTHORSHIP, NOT AS PRODUCTS OF INDUSTRIOUS LABOR.....	12
III. UNDER THE PROPER STATUTORY ANAL- YSIS, FEIST TOOK NOTHING COPYRIGHT- ABLE, SO THERE WAS NO INFRINGE- MENT .....	17
IV. THE COURTS BELOW IGNORED THE STATUTORY PREREQUISITES TO, AND LIMITATIONS ON, COPYRIGHT OF COM- PILATIONS OF FACTS .....	18
V. THE INDEPENDENT CANVASS REQUIRE- MENT IMPOSED BY THE COURTS BELOW CANNOT BE RECONCILED WITH THE STATUTE .....	23

## TABLE OF CONTENTS—Continued

	Page
VI. THE COPYRIGHT ACT EXPRESSLY PRE-EMPTS EQUIVALENT RIGHTS AND REMEDIES SUCH AS THE "SWEAT OF THE BROW" TEST .....	26
CONCLUSION .....	30

## TABLE OF AUTHORITIES

CASES	Page
<i>Alfred Bell &amp; Co. v. Catalda Fine Arts, Inc.</i> , 191 F.2d 99 (2d Cir. 1951) .....	13
<i>Baker v. Selden</i> , 101 U.S. 99 (1880) .....	8, 11
<i>Banks v. Manchester</i> , 128 U.S. 244 (1888) .....	8
<i>Black's Guide, Inc. v. Mediamerica, Inc.</i> , 1990 Copyright L. Dec. (CCH) ¶ 26,621 (N.D. Cal. 1990) .....	15
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 109 S. Ct. 971 (1989) .....	28, 29
<i>Bourjaily v. United States</i> , 483 U.S. 171 (1987) .....	21
<i>Central Tel. Co. v. Johnson Publishing Co.</i> , 526 F. Supp. 838 (D. Colo. 1981) .....	5, 19, 20
<i>Cincinnati &amp; Suburban Bell Tel. Co. v. Brown</i> , 44 F.2d 631 (S.D. Ohio 1930) .....	19
<i>Community for Creative Non-Violence v. Reid</i> , 109 S. Ct. 2166 (1989) .....	20, 21
<i>Compco Corp. v. Day-Brite Lighting, Inc.</i> , 376 U.S. 234 (1964) .....	27, 28
<i>Cooling Sys. &amp; Flexibles, Inc. v. Stuart Radiator, Inc.</i> , 777 F.2d 485 (9th Cir. 1985) .....	passim
<i>Durham Indus. v. Tomy Corp.</i> , 630 F.2d 905 (2d Cir. 1980) .....	28
<i>Eckes v. Card Prices Update</i> , 736 F.2d 859 (2d Cir. 1984) .....	13, 25
<i>Ehat v. Tanner</i> , 780 F.2d 876 (10th Cir. 1985), cert. denied, 479 U.S. 820 (1986) .....	27, 28, 29
<i>Erie R.R. v. Tompkins</i> , 304 U.S. 64 (1938) .....	8, 27
<i>Feist Publications, Inc. v. Rural Tel. Serv. Co.</i> , No. 88-1679 (10th Cir. March 8, 1990), cert. granted, 59 U.S.L.W. 3243 (U.S. Oct. 2, 1990) (No. 89-1909) .....	1
<i>Financial Information, Inc. v. Moody's Investors Serv.</i> , 751 F.2d 501 (2d Cir. 1984) .....	passim
<i>Financial Information, Inc. v. Moody's Investors Serv.</i> , 808 F.2d 204 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987) .....	passim
<i>Harper &amp; Row, Publishers v. Nation Enters.</i> , 471 U.S. 539 (1985) .....	passim
<i>Harper House, Inc. v. Thomas Nelson, Inc.</i> , 889 F.2d 197 (9th Cir. 1989) .....	16, 17



## TABLE OF AUTHORITIES—Continued

	Page
<i>Hartford Printing Co. v. Hartford Directory &amp; Publishing Co.</i> , 146 F. 332 (D. Conn. 1906) .....	19
<i>Herbert Rosenthal Jewelry Corp. v. Kalpakian</i> , 446 F.2d 738 (9th Cir. 1971) .....	16
<i>Hoehling v. Universal City Studios</i> , 618 F.2d 972 (2d Cir.), cert. denied, 449 U.S. 841 (1980) .....	17, 18, 23
<i>Hutchinson Tel. Co. v. Fronteer Directory Co.</i> , 770 F.2d 128 (8th Cir. 1985) .....	passim
<i>Illinois Bell Tel. Co. v. Haines &amp; Co.</i> , 905 F.2d 1081 (7th Cir. 1990), petition for cert. filed, No. 90-731 (Nov. 2, 1990) .....	23, 25
<i>Jeweler's Circular Publishing Co. v. Keystone Publishing Co.</i> , 274 F. 932 (S.D.N.Y. 1921), aff'd, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922) .....	24, 25, 26
<i>Konor Enters. v. Eagle Publications</i> , 878 F.2d 138 (4th Cir. 1989) .....	24
<i>Leon v. Pacific Tel. &amp; Tel. Co.</i> , 91 F.2d 484 (9th Cir. 1937) .....	passim
<i>Mazer v. Stein</i> , 347 U.S. 201 (1954) .....	8
<i>Miller v. Universal City Studios</i> , 650 F.2d 1365 (5th Cir. 1981) .....	15, 23, 24
<i>Mills Music, Inc. v. Snyder</i> , 469 U.S. 153 (1985) ..	6
<i>Morrissey v. Procter &amp; Gamble Co.</i> , 379 F.2d 675 (1st Cir. 1967) .....	16
<i>Nash v. CBS</i> , 899 F.2d 1537 (7th Cir. 1990) .....	25
<i>National Business Lists, Inc. v. Dun &amp; Bradstreet, Inc.</i> , 552 F. Supp. 89 (N.D. Ill. 1982) .....	12, 26
<i>Original Appalachian Artworks, Inc. v. Toy Loft, Inc.</i> , 684 F.2d 821 (11th Cir. 1982) .....	13
<i>Peckarsky v. ABC</i> , 603 F. Supp. 688 (D.D.C. 1984) .....	28
<i>Rockford Map Publishers, Inc. v. Directory Serv. Co.</i> , 768 F.2d 145 (7th Cir. 1985), cert. denied, 474 U.S. 1061 (1986) .....	23, 24
<i>Rural Tel. Serv. Co. v. Feist Publication</i> , 663 F. Supp. 214 (D. Kan. 1987) .....	5
<i>Schroeder v. William Morrow &amp; Co.</i> , 566 F.2d 3 (7th Cir. 1977) .....	15, 25
<i>Sears, Roebuck &amp; Co. v. Stiffel Co.</i> , 376 U.S. 225 (1964) .....	28

## TABLE OF AUTHORITIES—Continued

	Page
<i>Sony Corp. v. Universal City Studios</i> , 464 U.S. 417 (1984) .....	7
<i>Southern Bell Tel. &amp; Tel. Co. v. Associated Tel. Directory Publishers</i> , 756 F.2d 801 (11th Cir. 1985) .....	passim
<i>Southern Bell Tel. &amp; Tel. Co. v. Donnelly</i> , 35 F. Supp. 425 (S.D. Fla. 1940) .....	19
<i>Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv.</i> , 371 F. Supp. 900 (W.D. Ark. 1974) .....	19
<i>Stewart v. Abend</i> , 110 S. Ct. 1750 (1990) .....	11
<i>Suid v. Newsweek Magazine</i> , 503 F. Supp. 146 (D.D.C. 1980) .....	27
<i>Teleprompter Corp. v. CBS</i> , 415 U.S. 394 (1974) ..	6
<i>Trade-Mark Cases</i> , 100 U.S. 82 (1879) .....	8
<i>United Tel. Co. v. Johnson Publishing Co.</i> , 855 F.2d 604 (8th Cir. 1988) .....	passim
<i>Warner Bros. Inc. v. American Broadcasting Cos.</i> , 720 F.2d 231 (2d Cir. 1983) .....	28
<i>West Publishing Co. v. Mead Data Central, Inc.</i> , 616 F. Supp. 1571 (D. Minn. 1985), aff'd, 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987) .....	29
<i>Wheaton v. Peters</i> , 33 U.S. (8 Pet.) 591 (1834) ....	5
<i>Worth v. Selchow &amp; Righter Co.</i> , 827 F.2d 569 (9th Cir. 1987), cert. denied, 485 U.S. 977 (1988) .....	17, 25
<b>U.S. CONSTITUTION</b>	
U.S. Const. art. I, § 8, cl. 8 .....	7, 12, 27
<b>STATUTES</b>	
Copyright Act of 1909, Ch. 320, 35 Stat. 1075 (recodified 1947, repealed 1976) .....	10, 12
17 U.S.C. § 7 (current version at 17 U.S.C. § 103(b) (1988)) .....	10
17 U.S.C. § 24 (current version at 17 U.S.C. § 304(a) (1988)) .....	12
Copyrights Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541-98 .....	passim
17 U.S.C. § 101 (1988) .....	passim
17 U.S.C. § 102 (1988) .....	18, 27
17 U.S.C. § 102(a) (1988) .....	20

## TABLE OF AUTHORITIES—Continued

	Page
17 U.S.C. § 102 (b) (1988) .....	7, 11
17 U.S.C. § 103 (1988) .....	11, 18, 27
17 U.S.C. § 103 (a) (1988) .....	<i>passim</i>
17 U.S.C. § 103 (b) (1988) .....	<i>passim</i>
17 U.S.C. § 106 (1988) .....	4, 29
17 U.S.C. § 201 (b) (1988) .....	21
17 U.S.C. § 301 (1988) .....	27, 29
17 U.S.C. § 301 (a) (1988) .....	5
17 U.S.C. § 301 (b) (3) (1988) .....	29

## LAW REVIEWS AND TREATISES

Denicola, <i>Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works</i> , 81 Colum. L. Rev. 516 (1981) .....	19
Litman, <i>Copyright, Compromise, and Legislative History</i> , 72 Cornell L. Rev. 857 (1987) .....	11
1 M. Nimmer & D. Nimmer, <i>Nimmer on Copyright</i> (1990) .....	6, 23, 26
Patry, <i>Copyright in Collections of Facts: A Reply</i> , 6 Comm. & Law 11 (October 1984) .....	10, 19
Patry, <i>Copyright in Compilations of Facts, or Why the White Pages of a Telephone Directory Are Not Copyrightable</i> , 12 Comm. & Law 4 (December 1990) .....	10
W. Patry, <i>Latman's the Copyright Law</i> (6th ed. 1986) .....	5, 9
Patterson & Joyce, <i>Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations</i> , 36 UCLA L. Rev. 719 (1989) .....	5, 6, 29

## LEGISLATIVE MATERIALS

H.R. Rep. No. 1476, 94th Cong., 2d Sess., reprinted in 1976 U.S. Code Cong. & Admin. News 5659 .i, 10, 20, 27	
Register of the Copyrights, 87th Cong., 1st Sess., Report on the General Revision of the U.S. Copyright Law (Comm. Print 1961) .....	10

## RULES AND REGULATIONS

Directive of the State Corporation Commission of Kansas (May 1, 1967) .....	3
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**BRIEF OF ASSOCIATION OF  
NORTH AMERICAN DIRECTORY PUBLISHERS,  
THE DIRECTORY PUBLISHERS ASSOCIATION,  
MEAD DATA CENTRAL, INC.,  
AND DONNELLEY MARKETING, INC.  
AS AMICI CURIAE IN SUPPORT OF PETITIONER  
FEIST PUBLICATIONS, INC.**

## PRELIMINARY STATEMENT

The Association of North American Directory Publishers, the Directory Publishers Association (the "Associations"), Mead Data Central, Inc. ("Mead"), and Donnelley Marketing, Inc. ("Donnelley Marketing") (the "Companies"), submit this brief as *amici curiae*, pursuant to Rule 37.3 of the Rules of this Court, in support of petitioner Feist Publications, Inc. ("Feist").<sup>1</sup>

## INTEREST OF THE AMICI CURIAE

The Associations are international trade associations comprised of over 120 publishers of telephone directories. Their members publish "independent" telephone directories, *i.e.*, directories other than those published by or for local telephone companies.<sup>2</sup>

Mead is an electronic publisher providing online legal, news, and business information, primarily through the LEXIS® and NEXIS® services. Mead has a subsidiary that publishes electronic medical information (Micro-medex, Inc.) and divisions that publish computer software (Jurisoft) and hard copy legal publications (The Michie Company). As a database publisher, Mead is

<sup>1</sup> This brief is submitted on consent of the parties. The written consents of Petitioner and Respondent have been lodged with the Clerk of the Court.

<sup>2</sup> This Court has already recognized the interest of the Associations in granting their motion for leave to file a brief *amici curiae* in support of the petition for writ of *certiorari* of Feist. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, No. 88-1679 (10th Cir. March 8, 1990), *cert. granted*, 59 U.S.L.W. 3243 (U.S. Oct. 2, 1990) (No. 89-1909). In the interest of brevity, the Associations incorporate their earlier statement of interest as if fully set forth herein. See Brief of the Association of North American Directory Publishers and the Directory Publishers Association as *Amici Curiae* in Support of Petitioner Feist Publications, Inc., at 1-3.



concerned about compilation copyright issues as they affect Mead's ability to use fact compilations and public domain materials in its databases.

Donnelley Marketing is one of the nation's leading direct marketing firms and maintains a national consumer database of over eighty million United States households. The database is used by a vast "who's who" list of American businesses and industries to test, promote, and market their products and services; political and charitable groups also use the database to identify and communicate with the public. Donnelley Marketing is critically concerned that name, address, and telephone number data in telephone directories, and other public domain data, remain freely accessible and usable in the creation and development of other products and services.

As the Companies' joinder on this brief demonstrates, the compilation copyright issues presented here transcend telephone directories and extend to virtually any medium that incorporates fact data, such as data bases, mailing lists, membership lists, and other fact-based compilations. This Court's ruling on the correct legal basis and scope of copyright protection for fact compilations will bring much needed guidance in an increasingly important area of intellectual property to a wide range of United States businesses and industries.

This case presents particular issues of special interest to the Associations and Companies. The decisions below reflect the invocation of archaic "sweat of the brow" precedents under the copyright laws to afford protection to the labor involved in compilations, rather than, as the Constitution permits, to the "writings" of an "author." The decisions below are a form of judicial regulation of competition in an industry (here, the classified directory advertising (yellow pages) business), in accordance with a particular court's view of what constitutes "fair" and "unfair" competition. Neither the Constitution nor the copyright laws allows copyright to be used other than to protect the "writings" of an "author."

If allowed to stand, the decisions below, like the other "sweat of the brow" telephone directory cases before them, will suggest to local monopoly telephone companies and others that they may control the dissemination and uses of a substantial body of basic, uncopyrightable fact information to the exclusion of the Associations' members, the Companies, and all others. The Constitution and the copyright laws forbid that result.

### STATEMENT OF THE CASE

Respondent, Rural Telephone Service Company, Inc. ("Rural Telephone"), is a telephone company granted monopoly status to provide telephone service to subscribers in certain areas of Kansas. Rural Telephone obtains subscriber listing data as a necessary by-product of its monopoly telephone service: When a new resident or business takes the most basic step of obtaining telephone service in a community served by Rural Telephone, Rural Telephone records, *inter alia*, that new customer's name and address as provided by the customer and then clerically provides a telephone number from the four digit suffixes available within the customer's exchange area. Rural Telephone's possession of such data, therefore, results from—and only because of—its actions as a public utility service provider, and not as an "author."

Like most telephone companies, Rural Telephone is required by regulation annually to publish its subscribers' names, addresses, and telephone numbers (the "white pages") in a telephone directory for the area in which it provides telephone service.<sup>3</sup> Rural Telephone's directory also includes a separate classified section that lists business subscribers and contains advertisements, organized by descriptive headings, printed on yellow paper (the "yellow pages").

Petitioner, Feist, is an independent publisher of telephone directories containing, *inter alia*, white and yellow

<sup>3</sup> Directive of the State Corporation Commission of Kansas (May 1, 1967).

pages. One of Feist's directories covers an area that includes the service area of Rural Telephone. Feist competes with Rural Telephone for yellow pages advertisers.

In preparing its directory, Feist followed, where it could, the customary practice among independent directory publishers of obtaining subscriber listing data under license from the telephone companies.<sup>4</sup> This practice reflects the business reality that obtaining the most recent data available from the sole practical source of the data, in a convenient form (*e.g.*, on a magnetic tape), is of value to an independent publisher; it says and concedes nothing about the telephone companies' entitlement to assert copyright protection for elemental fact data published in telephone directories. This practice does, however, help to explain the telephone companies' interest in preserving an archaic and impermissibly expansive doctrine of copyright protection for their published directories: If the telephone companies can assert the copyright to prevent resort to the published directory, they can manipulate the quality of competing directories and command an even greater monopoly premium for whatever data they may or may not choose to provide by license from their continuously updated computer databases to independent directory publishers and others. The 1976 Act does not permit a copyright to be used in this manner. *See* 17 U.S.C. § 106.

Because Rural Telephone would not directly provide current subscriber listing data to Feist, Feist used the Rural Telephone directory as a second best source of names, addresses, and telephone numbers of businesses and residences in Rural Telephone's utility service area. Feist used this fact data to publish the white pages portion of its directory. Rural Telephone subsequently filed suit against Feist, alleging that Feist's use of the name, address, and telephone number fact data appearing in the Rural Telephone directory infringed Rural Telephone's copyright.

<sup>4</sup> *See* Brief of Appellant ("App. Brief"), p. 5; J.A. 51.

The district court held, without analysis, that the copyright in a telephone directory precludes any use of the data in that directory by another publisher for any purpose other than to verify the results of the second publisher's own independent canvass of telephone subscribers. *Rural Tel. Serv. v. Feist Publications*, 663 F. Supp. 214, 219 (D. Kan. 1987) (citing *Central Tel. Co. v. Johnson Publishing Co.*, 526 F. Supp. 838, (D. Colo. 1981) ("*CenTel v. Johnson*")) (Appendix to the Petition for Writ of *Certiorari* ("Cert. App."), p. 13a). Because Feist had not first undertaken the pointless and infeasible task of independently collecting the names, addresses, and telephone numbers of nearly five thousand residents of an eleven county area comprising 16,000 square miles, Brief of Appellant ("App. Brief"), p. 33, the court found that Feist had infringed Rural Telephone's copyright in the directory. *Id.* (Cert. App., p. 14a). The court also rejected Feist's "fair use" defense.

The Tenth Circuit, in an unpublished opinion, affirmed the decision for "substantially the reasons given by the district court." Cert. App., p. 4a.

#### SUMMARY OF THE ARGUMENT

Copyright is the grant of a limited *statutory* monopoly; it does not exist as a matter of "natural" or common law. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 657-58 (1834).<sup>5</sup> The starting point for any question concerning copyright is thus the 1976 Copyright Act.<sup>6</sup>

<sup>5</sup> *See also* Patterson & Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 732 (1989) ("*Patterson & Joyce*"). The scheme of state common law copyright for unpublished works that coexisted with the federal statutory copyright for fixed published works was abolished by the 1976 Copyright Act. 17 U.S.C. § 301(a); W. Patry, *Latman's the Copyright Law* 75-76 (6th ed. 1986). The other pertinent consequences of this statutory preemption of state law are discussed in Section VI, *infra*.

<sup>6</sup> The copyright statute currently in effect and applicable to this case was enacted in 1976 and became effective in 1978. Copyrights Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541-98 (1976)



This case involves the provisions of the 1976 Act that concern "compilations." Sections 101 and 103(a) of the 1976 Act provide that a compilation of facts or "data" is copyrightable if, and only to the extent that, it embodies sufficient original *authorship* (i.e., original selection, coordination, or arrangement) to constitute, as a whole, an original work of authorship. Section 103(b) also provides that, even where a fact compilation does entail sufficient original authorship to be copyrightable as a whole, the compilation copyright affords no protection against copying, from the compilation, of the pre-existing material (i.e., facts or "data") contained therein. In this respect, the 1976 Act implements the constitutional limits on copyright: Copyright is available only for the "writings" of "authors," and no one can be the author of facts. Facts, like ideas, belong to the public, which is not only permitted, but encouraged, to copy and use them freely. See *Teleprompter Corp. v. CBS*, 415 U.S. 394, 398 n.2 (1974). The statute, in short, equates authorship with original expression.

To implement these limitations on the scope of copyright protection in a compilation of data, such as a telephone directory, a court must clearly identify the copyrightable (i.e., original) authorship of the compiler and distinguish it from the unprotectable data. If all that is taken from the allegedly infringed compilation is the data (such as names, addresses, and telephone numbers), there can be no infringement; only a substantial taking of authorship (i.e., expression) can be an infringement.

(codified as amended at 17 U.S.C. §§ 101-119, 201-205, 301-305, 401-412, 501-510, 601-603, 701-710, 801-810 (1988) ("the 1976 Act"). The 1976 Act, reflecting a "delicate balance of competing interests," *Patterson & Joyce, supra* note 5, at 781, worked out over a twenty year period, was not a mere restatement of the prior law, but a substantial departure in form and substance from the earlier act. See *Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 552 (1985); *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 159-60 (1985); 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* vi (1990) ("Nimmer") (Preface to the 1978 Comprehensive Treatise Revision) (Copyright Act now like Internal Revenue Code).

The taking of facts or ideas alone cannot constitute infringement by reason of, *inter alia*, Section 102(b) as well as Section 103(b).

The fundamental error in the decisions below, and in the case law upon which those decisions rely, is the failure to recognize that copyright does not and cannot prohibit the copying, from a copyrighted work, of facts or ideas contained in the work. To prohibit the taking of data—whether on an industrious collection ("sweat of the brow") theory or because they appear in conjunction with protected authorship—conflicts with the Constitution and the 1976 Act.

The courts are not at liberty to provide copyright protection or the functional equivalent thereof other than in the manner and to the extent that Congress expressly provides in the copyright law. It is Congress, not the courts, that is entrusted with the responsibility for balancing the competing interests of businesses and the public's interest in determining what is protectable by copyright. The courts below have ignored Congress's determination and instead engrafted upon the copyright law judicially constructed notions of unfair competition and misappropriation, thereby impermissibly substituting their assessment of the balance among competing interests for that of Congress. In so doing, the courts below have taken from the public domain material—in this case, elemental facts—that the Constitution and the copyright law unconditionally commit to the public domain.

### ARGUMENT

"As the text of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product." *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 429 (1984).<sup>7</sup>

<sup>7</sup> U.S. Const. art. I, § 8, cl. 8 confers upon Congress the power "[t]o promote the Progress of Science and useful Arts, by secur-

Congress has carefully sought in the federal copyright law to protect only the *expression* of "ideas" or "facts," and not the "ideas" or "facts" themselves. This "idea/expression dichotomy 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.'" *Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 556 (1985) (citation omitted) ("*Harper & Row*").<sup>8</sup>

The 1976 Act affirms that the traditional, constitutionally based idea/expression dichotomy in copyright applies to compilations of facts just as it applies to all other "literary works." 17 U.S.C. § 103(a). Where a work—be it a telephone directory, a treatise on history, a collection of court decisions, or some other form of work—contains both protectable original expression of an author and unprotectable (*e.g.*, factual or public domain) material, only the original expression is protected by copyright. *Harper & Row*, 471 U.S. at 556-57; *Banks v. Manchester*, 128 U.S. 244, 251-52 (1888); *Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

The Constitution also prohibits federal courts from formulating a common law gloss on the copyright laws to extend the limited monopoly of copyright protection beyond the limits set by the Constitution and implemented by Congress in the copyright statute. *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938) ("*Erie*"). Federal courts are limited to following the Constitution, acts of Congress, and, where permitted, state law. *Id.* at 78. In the case of copyright, the Constitution empowers Congress to legislate, and Congress has done so, exercising in that process its prerogative to preempt state law.

ing for limited Times to Authors . . . the exclusive Right to their respective Writings . . . ."

<sup>8</sup> It has always been a fundamental principle of the copyright laws, reflecting our societal needs to communicate and to balance the First Amendment guarantee of freedom of speech with copyright protection, that "protection is given only to the expression" of an author's ideas or facts, not to the ideas or facts themselves. *Mazer v. Stein*, 347 U.S. 201, 217 (1954); see also *Baker v. Selden*, 101 U.S. 99, 102-03 (1880) ("*Baker*").

## I. THE 1976 COPYRIGHT ACT DEFINES THE NATURE AND SCOPE OF COPYRIGHTS IN COMPILATIONS OF FACTS

### A. Nature Of "Compilations"

The work at issue in this case, a combined white and yellow pages telephone directory, is one of a variety of works potentially encompassed within the 1976 Copyright Act's definition of a "compilation." To be copyrightable as a "compilation," a work must meet the 1976 Act's definition of a "compilation," which requires original authorship. The 1976 Act defines a "compilation" as

a work formed by the collection and assembling of preexisting materials or of data *that* are selected, coordinated, or arranged in such a way *that* the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101 (emphasis added).

Only works meeting all three of the conjunctive elements of this definition (as delineated by the emphases) may be "compilations" protected by copyright. 17 U.S.C. § 103(a). Those elements are:

- (1) a collection and assembling of preexisting materials or data;
- (2) that are then selected, coordinated, or arranged in an original manner;
- (3) thereby resulting in a work that is, as a whole, an "original work of authorship."

See W. Patry, *Latman's the Copyright Law* 63-64 (6th ed. 1986).

### B. Limitations On The Scope Of Copyright In Compilations

The limitation of copyright in compilations (as defined) to the work as a whole is reinforced by Section 103 (b) of the Act:

The copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or



enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 103(b). This provision responds to concerns expressed by the Register of Copyrights that some decisional law under the 1909 Copyright Act had deviated from a proper understanding of copyright law.<sup>9</sup> As the legislative history of this limitation states:

Section 103(b) [17 U.S.C. § 103(b)] is also intended to define, more sharply and clearly than does section 7 of the present law [former 17 U.S.C. § 7], the important interrelationship and correlation between protection of preexisting and of "new" material in a particular work. The most important point here is one that is commonly misunderstood today: copyright in a "new version" covers only the material added by the later author, and has no effect one way or the other on the copyright or public domain status of the preexisting material.

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 57, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5670 (bracketed material added).<sup>10</sup>

<sup>9</sup> Copyright Act of 1909, Ch. 320, 35 Stat. 1075 (recodified 1947, repealed 1976). See Register of the Copyrights, 87th Cong., 1st Sess., *Report on the General Revision of the U.S. Copyright Law* 9-10 (Comm. Print 1961). The Register's position was that former Section 7 afforded copyright protection in compilations "only to the new elements, and does not affect the . . . public domain status of the preexisting material." *Id.* at 9. The Register observed that "[w]hat the present statute fails to make clear is the basic requirement that the new elements must in themselves represent original creative authorship." *Id.* The Register proposed language that became, through editorial revision, Section 103(b) of the 1976 Act. *Id.* A more complete discussion of the pertinent legislative history of this provision will appear in a forthcoming article by Mr. William Patry, Policy Planning Advisor to the Register of Copyrights, United States Copyright Office: Patry, *Copyright in Compilations of Facts, or Why the White Pages of a Telephone Directory Are Not Copyrightable*, 12 *Comm. & Law* 4 (December 1990); see also Patry, *Copyright in Collections of Facts: A Reply*, 6 *Comm. & Law* 11, 20-25 (1984) ("Patry, A Reply").

<sup>10</sup> The legislative history further notes that "[b]etween them the terms 'compilations' and 'derivative works' which are defined

Thus, Sections 101 and 103 establish a complementary pair of principles for determining the nature and scope of copyright in compilations: (1) a work must embody original authorship to be copyrightable as a "compilation," with originality defined by the tripartite conjunctive structure of the definition of "compilations" (17 U.S.C. § 101); and (2) any copyright in a compilation extends only to the compilation as a whole and to the original selection, coordination, and arrangement, and *excludes* from the scope of that copyright the incorporated data (17 U.S.C. § 103(b)).

In addition to the limitations imposed by Sections 101 and 103(b) of the 1976 Act, Section 102(b) codifies the longstanding axiom in copyright law that copyright does not protect ideas, but only the expression of ideas:<sup>11</sup>

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b). The effect of this provision here is to make clear that copyright can neither be based upon, nor used to protect, the clerical or mechanical processes or business methods of a compiler, no matter how they are embodied in the compilation; only the authorship (if any) in the finished work is protectable. General or generic concepts concerning the appearance or organization of a fact compilation, being ideas or methods, are not "authorship" and therefore also not protectable by copyright.

in section 101, comprehend every copyrightable work that employs preexisting material or data of any kind." *Id.* Determining the scope of copyright protection available in either type of work, therefore, necessarily requires the same analysis; namely, distinguishing the unprotectable "preexisting material or data" from the protectable authorship (*i.e.*, original expression), if any. See *Stewart v. Abend*, 110 S. Ct. 1750, 1762-63 (1990); Litman, *Copyright, Compromise, and Legislative History*, 72 *Cornell L. Rev.* 857, 859-60 (1987).

<sup>11</sup> See *Baker*, 101 U.S. at 102-03.



The white pages of telephone directories typically contain no originality at all; rather, they are just the inevitable product of automated clerical work to array facts in a generic and unoriginal format that makes the directory functional. Therefore, absent an unlikely showing in a particular case that the white pages of a particular telephone directory do embody original authorship in their selection, coordination, or arrangement, the white pages of a telephone directory are not, of themselves, protected by the copyright in a telephone directory.<sup>12</sup>

## II. THE 1976 COPYRIGHT ACT PROVIDES COPYRIGHT PROTECTION FOR COMPILATIONS ONLY AS WORKS OF AUTHORSHIP, NOT AS PRODUCTS OF INDUSTRIOUS LABOR

The labor or industriousness ("sweat of the brow") theory adopted by the courts below effectively negates the conjunctive structure of the statutory definition of "compilation" by requiring only one of the three necessary elements: namely, "the collection and assembling of pre-

<sup>12</sup> See *Coolings Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 492 (9th Cir. 1985) ("Cooling Sys.") ("Obviously an alphabetical list is not a protectible form of arranging proper names."); *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89, 93 (N.D. Ill. 1982) ("Indeed, in this case the alphabetizing of a list of names could hardly have been the originality which Congress meant to reward."). Even if the "idea" of an alphabetical list of telephone subscribers' names, addresses, and telephone numbers were copyrightable, that idea long ago entered the public domain. As noted by the Ninth Circuit in *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) ("*Leon*"), Pacific Telephone produced and registered such lists annually between 1908 and 1935. *Id.* at 485. Assuming that Pacific Telephone was the "author" of this format, under the 1909 Act, whatever might have been protected by copyrights entered the public domain no later than 1983. See former 17 U.S.C. § 24 (duration of copyright twenty-eight years, plus forty-seven years resulting from congressional extensions of renewal period during negotiations of 1976 Act). To hold otherwise would mean that the copyright protection, if any, in such a work would be perpetual, in violation of U.S. Const. art. I, § 8, cl. 8, which confers the power of copyright only "for a limited Time to Authors," and of the federal copyright laws enacted thereunder.

existing materials or of data." 17 U.S.C. § 101. The constitutional limitation of copyright protection to the "writings" of "authors," as expressed in the 1976 Copyright Act, requires more. In addition to the industriousness inherent in collecting data (*e.g.*, acquiring or updating them) and assembling data (*e.g.*, putting them in alphabetical or numerical sequence), the 1976 Act requires selection, coordination, or arrangement of the data "in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101.

Neither the 1976 Act nor its legislative history contains any express definition of the terms "selected," "coordinated," or "arranged" as used in Section 101. The courts that have undertaken to follow and apply the statutory requirement have recognized that it requires a case-by-case assessment to determine whether a particular work embodies selection, coordination, or arrangement that is both original with the compiler (*i.e.*, not copied from someone else)<sup>13</sup> and more than merely clerical, mechanical, inevitable, or generic to the particular kind of work. This approach is reflected in a number of recent cases.

In *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) ("*Eckes*"), for example, the court held that an evaluative guide to baseball cards was a copyrightable compilation, based upon the compiler's exercise of "selection, creativity and judgment" in subjectively classifying baseball cards according to their value and condition. *Id.* at 862-63. The court determined that the compiler's "subjective selection and arrangement of information" was protectable by copyright, and was infringed by the defendant's copying of the plaintiff's subjective evaluation of the cards. *Id.* at 862.

In *Financial Information, Inc. v. Moody's Investors Service*, 751 F.2d 501 (2d Cir. 1984) (Newman, J., con-

<sup>13</sup> See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951). The determination of whether a work is sufficiently original to merit copyright protection is one of fact. *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 824-25 (11th Cir. 1982).

curing) ("*FII-1*"), and *Financial Information, Inc. v. Moody's Investors Service*, 808 F.2d 204 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987) ("*FII-2*"), the Second Circuit twice considered whether "Daily Bond Cards" regarding municipal bonds<sup>14</sup> were copyrightable and, if so, whether the copying of factual information from the cards constituted infringement. The court remanded the first appeal for the prerequisite fact finding of just what authorship—in terms of selection, coordination, or arrangement—there might be, if any, in the daily bond cards.<sup>15</sup> The Second Circuit subsequently affirmed the district court's conclusion on remand that the daily bond cards were not copyrightable, since they did not embody authorship but were, rather, products of a "simple clerical task" of compiling the data from newspapers around the country. *FII-2*, 808 F.2d at 206. The court noted that the 1976 Act "requires that copyrightability not be determined by the amount of effort the author expends, but rather by the nature of the final result." *Id.* at 207.

The Eleventh Circuit in *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Pub-*

<sup>14</sup> The information on the cards "typically include[d] the identity of the issuing . . . municipal authority, the series of bonds being called, the date and price of the redemption, and the name of the trustee or paying agent to whom the bond should be presented for payment." *FII-1*, 751 F.2d at 502.

<sup>15</sup> Concurring in this result, Judge Newman faulted the majority for its apparent reluctance to apply the 1976 Act as it is written and, in this regard, observed:

I do not share the view that Congress, in establishing these criteria [original selection, coordination, or arrangement], or this Court, in insisting that they be satisfied, has defined [sic: defied] the laws of logic or of algebra. The "whole" of a copyrightable "compilation" is not greater than the sum of its "parts." If its "parts" are only the discrete items of data that have been collected, the resulting work is not copyrightable. It may receive a valid copyright only if something has been added to the data: the "authorship" of the compiler in making the requisite selection, coordination, or arrangement of the data.

*FII-1*, 751 F.2d at 510.

*lishers*, 756 F.2d 801 (11th Cir. 1985) ("*ATD*"), correctly interpreted the 1976 Act in finding infringement of a telephone directory copyright, stating:

[A] telephone directory compilation whose components are comprised exclusively of information in the public domain can be protected by the copyright laws only as to the selection and arrangement of the compilation, the work as a whole, and not as to the preexisting information.

*Id.* at 810. The court cited with approval the observation in *Miller v. Universal City Studios*, 650 F.2d 1365, 1369-70 (5th Cir. 1981) ("*Miller*"), that "mere use of the information contained in a directory without a substantial copying of the format does not constitute infringement." As the *ATD* defendant had literally photocopied entire pages of the classified advertising (yellow pages) section of the plaintiff's directory (including, *inter alia*, graphics, artwork, layout, and textual material), the court properly found that the defendant had infringed the copyright protection for the plaintiff's format.

By comparison, the same analysis under different facts led to a finding of no infringement in *Black's Guide, Inc. v. Mediamerica, Inc.*, 1990 Copyright L. Dec. (CCH) ¶ 26,621 (N.D. Cal. 1990). The alleged infringer in *Black's Guide* had copied listings of office space rentals (including address, price, leasing agent, and other relevant data grouped by city) from an existing office leasing guide and used that data to publish a competing guide. *Id.* at 23,684. The court ruled in favor of the defendant on the grounds that (a) the defendant had copied only unprotectable data from the plaintiff's leasing guide, and (b) a comparison of the two works revealed no substantial similarity in the expression or arrangement of the data. *Id.* at 23,687.<sup>16</sup> While there were indeed many sim-

<sup>16</sup> In reaching this conclusion, the court expressed some concern over the possible inconsistency between the Ninth Circuit's cases (such as *Cooling Sys.*) and this Court's decision in *Harper & Row*. *Id.* at 23,686. Those concerns were misplaced because, as noted *infra*, n.28, this Court's citation to *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977) ("*Schroeder*") certainly did not



ilarities in the content and format of the two guides, the court noted that the generic nature of leasing guides permitted "only a narrow range of possible expressions to remain functional,"<sup>17</sup> and that the copyright protection in such a guide was thus extremely limited. *Id.*<sup>18</sup>

extend to its stated rationale. This Court's paraphrase of the "Golden Rule" in *Harper & Row*, 471 U.S. at 559 n.3, had to do with fair use, not with the availability or scope of copyright protection.

<sup>17</sup> The court's analysis seems to reflect the "idea/expression merger doctrine," which expresses the principle of copyright law that:

When the "idea" and its "expression" are thus inseparable, copying the "expressions" will not be barred, since protecting the "expression" in such circumstances would confer a monopoly of the "idea" upon the copyright owner free of the conditions and limitations imposed by the patent law.

*Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967). Where, as here, the nature of the compilation permits only a narrow range of possible designs or "expressions" to remain functional (i.e., listing alphabetically all telephone subscribers in a calling area), the protection afforded to the compilation must be extremely limited and cannot preclude copying of the "expression" (if any) necessary in order to obtain and use the unprotectable data.

<sup>18</sup> See also *Cooling Sys.*, 777 F.2d at 491-93 (affirming dismissal of infringement claims relating to automotive parts catalog after (1) noting that a compilation copyright holder "can claim to 'own' only an original manner of expressing ideas or an original arrangement of facts" in the compilation, and (2) emphasizing that the relevant test for "substantial similarity" between the plaintiff's and defendant's works "is not whether there is substantial similarity in the total concept and feel of the works, . . . but whether the very small amount of protectible expression in [plaintiff's] catalog is substantially similar to the equivalent portions of [defendant's] catalog"); *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 201-05 (9th Cir. 1989) (after noting that "[i]ssues involving the availability and extent of copyright protection . . . present mixed questions of law and fact," court held that an "organizer" (a kind of pocket calendar and notebook) enjoyed "only extremely limited copyright protection," and that infringement could only be found if there were "bodily appropriation of

### III. UNDER THE PROPER STATUTORY ANALYSIS, FEIST TOOK NOTHING COPYRIGHTABLE, SO THERE WAS NO INFRINGEMENT

In this case, it was conceded on appeal that the telephone directory published by Rural Telephone, as a whole, is copyrightable. App. Brief, p. 13. That concession only relieved the courts below of the task of determining whether the Rural Telephone directory did, in fact, embody sufficient original authorship to be protectable at all.<sup>19</sup> Since the scope of copyright protection for Rural Telephone's directory cannot exceed the copyrightable original authorship in the directory, however, it remained necessary for the courts to determine just what it is that constitutes original authorship in the Rural Telephone book. This was not done.

Given the concession as to copyrightability, an efficient approach would have been to determine whether what Feist was accused of copying was unprotectable data or protectable authorship. This approach is similar in concept to that approved in *Hoehling v. Universal City Stu-*

expression,' . . . [by] copying or unauthorized use of substantially the entire item") (quoting *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987), cert. denied, 485 U.S. 977 (1988) (other citations omitted)). The court in *Harper House* reversed a jury verdict in favor of the plaintiff because the district court's jury instructions failed adequately to distinguish between protected and unprotected material in the compilation and thereby permitted infringement to be found "based upon the direct copying of such unprotected material." *Id.* at 208.

<sup>19</sup> The Associations concur that a typical telephone directory, composed of a distinctive cover, original text, and originality in the presentation of advertising material (generally in the yellow pages) embodies sufficient original authorship to warrant copyright protection for those limited elements of original authorship and against literal copying of the entire directory. The general format or structure of a telephone directory, comprising an alphabetical list of subscribers on white paper, a classified list of business subscribers mixed with advertising on yellow paper, and textual material, is, of course, generic to the concept of a telephone directory and clearly unprotectable.



dios, 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980) ("*Hoehling*"). Had the courts below done this, it would have become apparent immediately that no infringement of copyright had occurred. The complaint itself reveals that the claim of infringement in this case rests entirely upon the defendant's copying of "listings from plaintiff's copyrighted telephone directory." J.A. 9. "Listings" means names, addresses, and telephone numbers of subscribers to telephone service. Plaintiff's Motion for Summary Judgment, p. 8. Such names, addresses, and telephone numbers are prototypical examples of the sort of facts or "data" for which copyright protection is unavailable as a matter of law under the 1976 Act. There is not even an allegation that copyrightable authorship was copied. The complaint should therefore have been dismissed.

#### IV. THE COURTS BELOW IGNORED THE STATUTORY PREREQUISITES TO, AND LIMITATIONS ON, COPYRIGHT OF COMPILATIONS OF FACTS

The courts below ignored the plain requirements of the 1976 Act by failing to identify or discuss just what (if any) copyrightable original authorship is embodied in the Rural Telephone directory *as a whole* (the only basis of the asserted copyright), much less whether any copyrightable original authorship was present in the *white pages* section of the Rural Telephone directory. Instead, the courts below concluded that the mere taking of subscriber listing data constituted an infringement. The analysis and conclusions of the courts below are, therefore, irreconcilable with the 1976 Act.

The district court held, as a matter of law, that "the white pages of a telephone directory constitute original work of authorship and are, therefore, copyrightable under either the provisions of 17 U.S.C. § 102 or § 103." Cert. App., p. 10a. The court's opinion articulates no basis—factual or legal—for this conclusion apart from a string cite to cases, some of which, in generally conclu-

sory terms, have so held. Cert. App., p. 9a.<sup>20</sup> The Tenth Circuit approved this approach without further explanation. Cert. App., p. 3a.

Notably, none of the cases cited by the courts below applies the relevant legal requirements of the 1976 Act to the facts of this case.<sup>21</sup> Indeed, only three of the

<sup>20</sup> The district court also cited an article by Professor Denicola, Cert. App., p. 10a, the stated premise of which is that "total labor of production," rather than authorship, should be the basis for copyright protection in fact compilations and other fact works. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 530 (1981). Essentially, Professor Denicola takes exception to Congress's treatment of fact compilations and other nonfiction works in the 1976 Act. Professor Denicola's argument and analysis are criticized and refuted persuasively in Patry, *A Reply*, *supra* note 9, at 11. Whatever the merits of Professor Denicola's theory as a matter of policy, it is not the theory that Congress chose to incorporate into the 1976 Act.

<sup>21</sup> The district court below cited the following cases: *Hutchinson Tel. Co. v. Frontier Directory Co.*, 770 F.2d 128 (8th Cir. 1985) (court focused on efforts of plaintiff in compiling directory as basis for copyright protection); *ATD*, 756 F.2d 801 (finding infringement based on copying of coordination or arrangement (i.e., "format")); *Leon*, 91 F.2d at 484 (pre-1976 Act case holding that "industrious collection" alone merits copyright protection); *Centel v. Johnson*, 526 F. Supp. 838 (assuming copyrightability of facts based on registration certificate, without analysis of 1976 Act requirements); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv.*, 371 F. Supp. 900 (W.D. Ark. 1974) (pre-1976 Act case citing *Leon* with approval); *Southern Bell Tel. & Tel. Co. v. Donnelly*, 35 F. Supp. 425 (S.D. Fla. 1940) (pre-1976 Act case finding copyrightability of subscriber listing data based on copyright on directory as a whole); *Cincinnati & Suburban Bell Tel. Co. v. Brown*, 44 F.2d 631 (S.D. Ohio 1930) (pre-1976 Act case granting relief because defendants failed to appear without any finding that defendants' use of plaintiff's directory listings was illegal); *Hartford Printing Co. v. Hartford Directory & Publishing Co.*, 146 F. 332 (D. Conn. 1906) (pre-1976 Act case following precedent holding copyrightability based on labor, but questioning how copyright on directories promotes useful arts and sciences). The Tenth Circuit cited three of these cases in its opinion, *Hutchinson*, *ATD*, and *Nationwide*,

cases cited by the district court were decided after the effective date of the current copyright statute,<sup>22</sup> and none of them actually cites Section 103(b) of the 1976 Act (although the Eleventh Circuit's decision in *ATD* correctly acknowledges the limiting effect of that provision of the statute. *See ATD*, 756 F.2d at 810).<sup>23</sup>

The first and most recent case cited by the district court is the Eighth Circuit decision in *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985) ("*Hutchinson*"), which cites only Sections 101, 102(a), and 103(a) of the 1976 Act, and asserts, based solely on a portion of the legislative history of Section 102(a), that "[i]t thus appears that Congress intended that directories be copyrightable, thereby ratifying an unbroken line of cases holding telephone directories to be copyrightable." *Id.* at 131. In fact, as noted above, the legislative history of Section 103(b) clearly indicates Congress's intent to *reject* some of the decisional law in this area, which had so "commonly misunderstood" the fundamental distinction between protectable and unprotectable materials or data in compilations.<sup>24</sup> Even if Congress had not explicitly so stated, the obvious inconsistency between the pre-1976 case law and the requirements of the subsequent statute would have to be resolved by following the statute rather than inconsistent cases under a prior statute. *See Community for Creative Non-Violence v. Reid*,

and added a citation to *United Tel. Co. v. Johnson Publishing Co.*, 855 F.2d 604 (8th Cir. 1988), a case decided after the district court issued its opinion.

<sup>22</sup> *Hutchinson*, *ATD*, and *Centel v. Johnson*.

<sup>23</sup> The Eleventh Circuit's *ATD* decision recognizes the limited scope of copyright protection for fact compilations under the 1976 Act in a case involving photocopying of entire pages of the yellow pages (classified) section of a telephone directory. By illustrating what might constitute infringement of the copyright in a work such as a telephone directory under the 1976 Act, the *ATD* decision serves only to confirm the error of the opinions below.

<sup>24</sup> *See* discussion, *supra*, at 10-11.

109 S. Ct. 2166, 2177 (1989) ("*CCNV*") ;<sup>25</sup> *Bourjaily v. United States*, 483 U.S. 171, 177-79 (1987) ; *see also FII-1*, 751 F.2d at 510 ("The fact that some language in early cases . . . supported a view that copyright protection should be extended solely because of laborious effort is no reason for us to disregard the statutory criteria [authorship in the form of original selection, coordination, or arrangement] that Congress articulated in 1976 when it enacted the current statute. The 'sweat of the brow' rationale is no substitute for meeting one of those statutory criteria.").

The impossibility of reconciling the old "sweat of the brow" telephone directory cases with the requirements and limitations of the 1976 Act is perhaps best demonstrated by analysis of an Eighth Circuit opinion cited below by the Tenth Circuit. That opinion, *United Telephone Co. v. Johnson Publishing Co.*, 855 F.2d 604 (8th Cir. 1988) ("*United v. Johnson*"), found the taking from the white pages of a telephone directory of names, addresses, and telephone numbers to constitute copyright infringement. The court did so by a process of reverse logic wholly incompatible with the 1976 Act.

The first step in the *United v. Johnson* court's analysis was the apparently presumptive determination that the name, address, and telephone number data collected and assembled in the white pages section of the telephone company's directory (not the telephone company's directory as a whole, which was the basis of the copyright registration on which suit was brought) was a "compilation." This led directly to the apparently foregone conclusion that the white pages section of a telephone directory, of itself, fulfilled the statutory requirements for selection, coordination, or arrangement. *Id.* This approach

<sup>25</sup> In *CCNV*, 109 S. Ct. at 2177, the Court found that a number of decisions concerning the work for hire provision of the 1976 Act (17 U.S.C. § 201(b)) failed to recognize that the 1976 Act departed from, and thus supplanted, the prior case law. Accordingly, the Court overruled the inconsistent decisions. *Id.* at 2177. The Court should do likewise here.



was erroneous, because the existence of a copyright in any "compilation" (here, the entire directory) does not, of itself, establish exclusive rights in any particular part or element of the directory; a further finding that the part or element in question is original authorship is required before protection may be extended to it.

The *United v. Johnson* court proceeded to acknowledge that Section 103(b) of the 1976 Act precludes copyright protection for data and limits copyright in a compilation to the "protected expression." The court simply assumed, however, that there must be some "expression" (authorship) in the white pages. This apparently was deduced from the erroneous presumption that anything that can be called a "compilation" (in the common, rather than statutory, sense of the term) is copyrightable. 855 F.2d at 608. As previously shown, however, the statute sets a higher standard, and a copyrightable "compilation" must fulfill the statutory prerequisites.

The court then disposed of the limitation imposed by Section 103(b) of the 1976 Act by the artifice of defining the names, addresses, and telephone numbers in the previous year's white pages as the "preexisting material" and the names, addresses, and telephone numbers added and deleted in the process of collecting and assembling the current year's book as the "protected expression of the preexisting names, addresses, and telephone numbers of [the telephone company's] subscribers." *Id.* Since the alleged infringer (the publisher of a different form of directory, called a city directory, that contains personal and demographic information not included in a telephone directory) had taken from the telephone directory the "new" names, addresses, and telephone numbers, the court concluded that there had been a taking of protected expression. *Id.*

This treatment fails analysis for the obvious reason that names, addresses, and telephone numbers are and never cease to be elemental facts—not authorship or expression—and cannot be the subject of copyright protection, regardless of the point in time at which they or any

other data are collected or assembled. Research is not copyrightable. *Miller*, 650 F.2d at 1370-71; *Hoehling*, 618 F.2d at 979; see *Nimmer*, *supra* note 6, §§ 2.03[E], 2.11[A]. Simply calling data "protected expression of pre-existing facts" does not transform the data, or the "research" by which they are collected, into copyrightable expression.

The actual concern of the *United v. Johnson* court was not the protection of original authorship but with assuring to the plaintiff telephone company a competitive position *vis-a-vis* the defendant that the court deemed appropriate. This is revealed in the "substantial similarity" discussion, where the court observed that "an area resident who owns [the defendant's] city directory would find little reason to refer to the [plaintiff's telephone directory]." 855 F.2d at 609. In other words, the real concern here, as in all of the "sweat of the brow" cases, is regulation of the competitive relationship between the parties to the lawsuit, not intellectual property protection for the "writings" of "authors."

It simply is not possible to reconcile this sort of judicial regulation of competition with the 1976 Act: The "sweat of the brow doctrine" is fundamentally incompatible with the statute. See *FII-2*, 808 F.2d at 207; *Nimmer*, *supra* note 6, § 3.04 at 3-17 to 3-20.

#### V. THE INDEPENDENT CANVASS REQUIREMENT IMPOSED BY THE COURTS BELOW CANNOT BE RECONCILED WITH THE STATUTE

The failure by the lower courts and the other minority circuits<sup>26</sup> to conform their infringement determinations to the requirements of the 1976 Copyright Act is demonstrated by the "independent canvass" obligation they im-

<sup>26</sup> The decisions below adopt the "sweat of the brow" doctrine as applied by the Seventh and Eighth Circuits. See *Rockford Map Publishers, Inc. v. Directory Serv. Co.*, 768 F.2d 145 (7th Cir. 1985), *cert. denied*, 474 U.S. 1061 (1986) ("*Rockford Map*"); *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081 (7th Cir. 1990) ("*Haines*"), *petition for cert. filed*, No. 90-731 (Nov. 2, 1990); *Hutchinson*, 770 F.2d 128.



pose on subsequent compilers.<sup>27</sup> The practical effect of this requirement is to confer upon the first compiler of facts a virtual monopoly in them. This result is irreconcilable with a constitutional and statutory scheme that extends copyright protection only to authorship and not only denies such protection to facts or ideas, but promotes access to, copying, and use of such facts or ideas by others.

The "sweat of the brow" minority generally justifies the prior canvass requirement by citation to the 1922 and 1937 decisions in *Jeweler's Circular* and *Leon*; these cases, however, have been expressly disavowed by the majority<sup>28</sup> (including the very courts that decided them) on the ground that such a requirement is inconsistent with the 1976 Copyright Act.

The Second Circuit, for example, disavowed the reasoning of its 1922 opinion in *Jeweler's Circular* in light of the 1976 Act, stating as follows:

The [1976 Act] thus requires that copyrightability not be determined by the amount of effort the author expends, but rather by the nature of the final result. To grant copyright protection based merely on the "sweat of the author's brow" would risk putting large

<sup>27</sup> The prior independent canvass requirement was recently described by the Seventh Circuit as follows:

[A] second compiler may check back his independent work upon the original compilation. The right to "check back" does not imply a right to start with the copyrighted work. Everyone must do the same basic work, the same "industrious collection."

*Rockford Map*, 768 F.2d at 149 (citing *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 935 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922) ("*Jeweler's Circular*").

<sup>28</sup> In addition to the Second and Ninth Circuits (as discussed in text *infra*), the Fourth, Fifth, and Eleventh Circuits also do not follow the "sweat of the brow" doctrine, but instead properly follow the 1976 Act by requiring original authorship, rather than labor, to support copyright and determine its scope. See *Konor Enters. v. Eagle Publications, Inc.*, 878 F.2d 138, 140 (4th Cir. 1989); *ATD*, 756 F.2d at 809-10; *Miller*, 650 F.2d at 1369-70.

areas of factual research material off limits and threaten the public's unrestrained access to information.

*FII-2*, 808 F.2d at 207; see also *FII-1*, 751 F.2d at 506; *Eckes*, 736 F.2d at 862-63. Likewise, in disapproving its 1937 decision in *Leon*, the Ninth Circuit said in 1987 that:

We . . . cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. . . . It is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent.

*Worth v. Selchow & Righter Co.*, 827 F.2d 569, 574, *cert. denied*, 485 U.S. 977 (1988); *Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 491.<sup>29</sup>

<sup>29</sup> Notwithstanding the Ninth Circuit's disapproval of *Leon*, the Seventh Circuit again cited the decision this past summer in support of the proposition that "[o]ur conclusion that [telephone] directories are copyrightable finds ample support from several circuits and the Supreme Court." *Haines*, 905 F.2d at 1085. In support of this statement, the Seventh Circuit further relied upon this Court's citation in *Harper & Row*, 471 U.S. at 547, to the Seventh Circuit's *Schroeder* decision, 566 F.2d 3, for the proposition that "'a compilation of pure fact, entails originality.'" *Haines*, 905 F.2d at 1085 (citations omitted). What the Seventh Circuit failed to mention, and what this Court most certainly did not embrace, is the *Schroeder* court's further holding that "only 'industrious collection,' not originality in the sense of novelty, is required" for a finding of copyrightability. *Schroeder*, 566 F.2d at 5. That holding cannot be reconciled with the 1976 Act, which requires more than industrious collection but does not require "novelty" to support a copyright in a compilation of facts. The constitutional and statutory prerequisite for a copyright is *original authorship*. The failure of the Seventh Circuit to acknowledge this requirement may explain that court's persistence in extending copyright protection to uncopyrightable facts in contravention of the 1976 Act. But see *Nash v. CBS*, 899 F.2d 1537 (7th Cir. 1990).

In lieu of following the 1976 Act, the Eighth Circuit in *Hutchinson*, also chose to follow the Ninth Circuit's decision in *Leon*, 91 F.2d 484, which in turn followed the Second Circuit's decision in *Jeweler's Circular*, 281 F. 83. The Eighth Circuit chose to follow

# **VI. THE COPYRIGHT ACT EXPRESSLY PREEMPTS EQUIVALENT RIGHTS AND REMEDIES SUCH AS THE "SWEAT OF THE BROW" TEST**

In operation, the "sweat of the brow" doctrine employs the vehicle of copyright to vindicate a particular court's view of the appropriate reward for the labor and money invested in the collection and assembly of facts or data. *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 92, 94-95 (N.D. Ill. 1982) ("[T]he courts have long afforded protection under the copyright laws against appropriation of the fruits of the compiler's industry. \* \* \* The protection of the compiler's labor has been a basis for protecting telephone directories [citing, *inter alia*, *Leon*], . . . rating books, hotel and restaurant guides, . . . racing information, . . . jewelers' names and trademarks [citing *Jeweler's Circular*], cable and telegraphic codes, . . . and garden supplier lists."); *Nimmer, supra* note 6, § 3.04. In some of the telephone directory cases including this case and *Hutchinson*, the extension of copyright to unprotectable facts in the white pages (alphabetical) section of telephone directories is sought by, and granted to, the telephone companies in aid of their efforts to compete in the business of selling yellow pages (classified) directory advertising.

The holdings below result from the courts' view that Feist's use of the subscriber listing data in Rural Telephone's white pages was somehow competitively "unfair." In reaching this result, however, the courts ignored the authorship requirement in the 1976 Act and, instead, redrew for themselves the carefully drawn line between what should and should not be protected by copyright by engrafting common law notions of unfair competition onto the 1976 Act. It is unclear whether the lower courts (and the decisions to which they cite) have relied upon some form of judge-made federal common law of unfair competition or upon state unfair competition law as authority

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these cases even though both had previously been disavowed by the circuits that decided them.

for redrawing the scope of copyright protection under the 1976 Act. In either case, they have acted beyond their authority.

The Constitution prohibits the federal courts from amending the Copyright Act through judge-made federal common law. *Erie*, 304 U.S. at 78. To the extent that the minority courts are borrowing state common law principles in their decisions, Section 301 of the 1976 Act expressly preempts such remedies. 17 U.S.C. § 301. As explained by the Tenth Circuit itself in *Ehat v. Tanner*, 780 F.2d 876, 877-78 (10th Cir. 1985), *cert. denied*, 479 U.S. 820 (1986) ("*Ehat*"):

Congress expressly stated that section 301 is intended to prevent "the States from protecting . . . [a work] even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain." H. R. Rep. No. 1476, 94th Cong. 2d Sess. 131, reprinted in 1976 U.S. Code Cong. & Ad. News 5659, 5747. State law forbidding others to copy an article "unprotected by a patent or a copyright . . . would interfere with the federal policy, found in art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 [other citations omitted]; see also *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980).

Recognizing this mandate, the Tenth Circuit in *Ehat* refused to extend, under state common law claims, the equivalent of copyright protection to a researcher's copies of historical quotations. The copied quotations had been recopied by the defendants, without authorization, from the researcher's notes and then reproduced and sold to the public. *Id.* at 877. As the copied quotations were not copyrightable under either Section 102 or 103 of the 1976 Act, the Tenth Circuit ruled that the plaintiff's common law claim of misappropriation was preempted:



[W]e see no distinction between such a state right and those exclusive rights encompassed by the federal copyright laws. See *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 247 (2d Cir. 1983) ("state law claims that rely on the misappropriation branch of unfair competition are preempted"); [other citations omitted]. \* \* \* [Plaintiff] "cannot achieve by an unfair competition claim what [he] failed to achieve under [his] copyright claim." See *Durham Industries v. Tomy Corp.*, 630 F.2d 905, 918 (2d Cir. 1980).

*Ehat*, 780 F.2d at 878-79.

The Tenth Circuit has turned its own analysis of the 1976 Act in *Ehat* upside down here. Comparison of the decision in *Ehat* with the decision below vividly demonstrates how the "sweat of the brow" jurisprudence adopted and followed by the minority circuits has resulted in giving telephone directories more extensive copyright protection than other fact works despite the absence of any statutory basis for such disparate treatment. The courts may not, by the application of state statutory or common law principles, regulate the exploitation of fact information by the public—including, as in this case, potential competitors of the allegedly infringed party. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 109 S. Ct. 971, 985 (1989) ("*Bonito Boats*") (States "are simply not free . . . to offer equivalent protections" to that which Congress "has determined should belong to all."); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964) ("Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws."); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) ("[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article."); *Peckarsky v. ABC*, 603 F. Supp. 688, 695 (D.D.C. 1984) (purpose of broad statutory preemption scheme in Copyright Act

is to further Act's goal of encouraging contributions to recorded knowledge by precluding use of state law to prevent copying of material that Congress has determined should be left in public domain).

As explained in the context of the much-criticized *West Publishing* decision:<sup>30</sup>

[A]s a matter of equity, conscience, or prejudice, a judge may think it unfair that a publisher which has invested millions in publishing law reports should be without legal protection against citation of those reports by another. But the judge is not free to impose that sense of injustice upon the defendant by declaring that he or she has infringed the plaintiff's copyright by taking from the reports elements which copyright law does not protect. To confuse copyright with unfair competition . . . contravenes section 301 and upsets the delicate balance of competing interests—including, in addition to the property rights of the copyright owner, the public's interest in the accessibility of public domain materials—which the 1976 Act was designed to achieve.

*Patterson & Joyce*, *supra* note 5, at 781.<sup>31</sup> Reversal of the decision below will not only bring the law of compilation copyright into harmony with the intent of Congress under the 1976 Copyright Act, but also with the Tenth Circuit's own analysis of that intent in *Ehat*.

<sup>30</sup> *West Publishing Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987).

<sup>31</sup> Section 301 does preserve to the states causes of action based on "legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106." 17 U.S.C. § 301(b)(3). Thus, for example, a state law cause of action for unfair competition involving false labeling or fraudulent representation would not be preempted and would serve generally to protect consumers from confusion as to source. See *Bonito Boats*, 109 S. Ct. at 981.



**CONCLUSION**

For the foregoing reasons, the decision of the United States Court of Appeals for the Tenth Circuit should be reversed.

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